

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231 www.uspto.gov

APPLICATION NO.	F	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/131,744		08/10/1998	NORIBUMI KOITABASHI	884.2742	8265
5514	7590	02/24/2003			
		LLA HARPER &	EXAMI	EXAMINER	
30 ROCKE NEW YOR				GRENDZYNSK	I, MICHAEL E
				ART UNIT	PAPER NUMBER
				1774	0 &
				DATE MAILED: 02/24/2003	20

Please find below and/or attached an Office communication concerning this application or proceeding.

-			45-2					
		Application No.	Applicant(s)					
Office Action Summary		09/131,744	KOITABASHI ET AL.					
		Examiner	Art Unit					
		Michael E. Grendzynski	1774					
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply								
A SH THE - Exte after - If the - If NO - Failu - Any	ORTENED STATUTORY PERIOD FOR REP MAILING DATE OF THIS COMMUNICATION nsions of time may be available under the provisions of 37 CFR (SIX (6) MONTHS from the mailing date of this communication. e period for reply specified above is less than thirty (30) days, a report of the provision of the prov	I. 1.136(a). In no event, however, may a reply within the statutory minimum of thirt id will apply and will expire SIX (6) MON ute. cause the application to become AB	eply be timely filed y (30) days will be considered timely. THS from the mailing date of this communication. ANDONED (35 U.S.C. § 133).					
1)⊠	Responsive to communication(s) filed on 12	2 <u>December 2002</u> .						
2a) <u></u>	This action is FINAL . 2b)⊠ 3	This action is non-final.						
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.								
•	ion of Claims							
4)⊠	Claim(s) 1-16 is/are pending in the application.							
E1 5 2	4a) Of the above claim(s) <u>2, 8 and 10</u> is/are withdrawn from consideration.							
—	Claim(s) 1,4-7,9 and 11-16 is/are allowed.							
6)□	· · · · · · · · · · · · · · · · · · ·							
,	, ,	Claim(s) is/are objected to. Claim(s) <u>1-16</u> are subject to restriction and/or election requirement.						
•	ion Papers	i election requirement.						
• •	The specification is objected to by the Examin	ner.						
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.								
,—	Applicant may not request that any objection to							
11)[The proposed drawing correction filed on	is: a)∏ approved b)∏ c	lisapproved by the Examiner.					
If approved, corrected drawings are required in reply to this Office action.								
12) The oath or declaration is objected to by the Examiner.								
Priority	under 35 U.S.C. §§ 119 and 120							
13)[Acknowledgment is made of a claim for fore	ign priority under 35 U.S.C.	§ 119(a)-(d) or (f).					
a)	☐ All b)☐ Some * c)☐ None of:							
	1. Certified copies of the priority docume	nts have been received.						
	2. Certified copies of the priority documents have been received in Application No							
* ;	 Copies of the certified copies of the praphication from the International Esee the attached detailed Office action for a limited. 	Bureau (PCT Rule 17.2(a)).						
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).								
 a) The translation of the foreign language provisional application has been received. 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. 								
Attachme	nt(s)							
2) Noti	ce of References Cited (PTO-892) ce of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO-1449) Paper No(s	5) Notice of	Summary (PTO-413) Paper No(s) Informal Patent Application (PTO-152)					

Application/Control Number: 09/131,744

Art Unit: 1774

Allowable Subject Matter

1. Species "a" (claims 1,4-7, 9 and 11-16) are allowable over the prior art of record.

Election/Restrictions

2. The restriction requirement made in paper No. 26 is withdrawn. Claims 11-16 are hereby rejoined and have been fully examined for patentability. The restriction requirement of Paper No. 26, however, remains. The examiner has chosen species "c" of Paper No. 24 (claim 3) in continuing the prosecution of the instant application. Claims 2, 8 and 10 remain withdrawn from further consideration.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Application/Control Number: 09/131,744

Art Unit: 1774

4. Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-31 of copending Application No. 09/131,736. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to one of ordinary skill in the art to choose a first ink having a Ka of 1 ml/m² msec^{-1/2} and a second ink having a Ka of more than 1 ml/m² msec^{-1/2} (e.g., 5 ml/m² msec^{-1/2}), thus meeting the limitations of the instant claims. The use of the open-ended transition term comprising, moreover, permits *any* colorant to exist in the processing liquid.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 3 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 16 of U.S. Patent No. 6,379,000. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious for one of ordinary skill in the art to choose an ink having a Ka of less than 1 ml/m² msec^{-1/2} and a processing ink having a Ka of more than 1 ml/m² msec^{-1/2}, as directed by the claim.

Specification

6. The use of the trademark Acetylenol® has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Page 4

Application/Control Number: 09/131,744

Art Unit: 1774

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 8. Claim 3 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Koike (US 5608438). Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Koike (US 5608438). See Abstract. Applicants claim a recording method comprising the steps of (1) ejecting onto a recording material ink having a Ka value of not more than 1 ml/m² msec^{-½}, (2) heating the ink and (3) applying a processing liquid thereto having a second Ka value of at least 1 ml/m² msec^{-½}. Koike discloses an ink jet printing method comprising the steps of ejecting a first ink having a Ka value of 0.5 ml/m² msec^{-½} or less and jetting an second ink onto the first ink having a Ka of at least 1.0 ml/m² msec^{-½}. See Abstract. The second ink is equivalent to applicants' processing liquid—the use of the open-ended transition term "comprising" does not exclude a colorant from existing in the processing liquid. Koike further discloses that a heating step is carried out continuously using a heater located on the recording device. See col. 9, ll 25-30.
- 9. Claim 3 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamamoto. Yamamoto discloses an ink jet recording process comprising the steps of (1) ejecting a first ink having a first surface tension onto a recording substrate and (2) ejecting a color ink including a second ink which is rendered insoluble by the first ink when mixed. See Abstract. The first ink is equivalent to applicants' ink having a Ka of a first value. All inks inherently possess a Ka value with respect to an absorbing surface. In its examples, Yamamoto discloses an embodiment where the first ink does not comprise any Acetylenol®. See Example 3. Consequently, this would meet applicants' definition of a topping-type ink (i.e., an ink having a Ka value of -1.0 ml/m² msec-½). The second ink, moreover, is equivalent to

Application/Control Number: 09/131,744

Art Unit: 1774

applicants' processing liquid. It comprises Acetylenol® in amounts equivalent to applicants' semi-

penetrative ink (i.e., a liquid having a Ka value of 1.0-5.0 ml/m² msec^{-1/2}). See Table 1. The use of the

open-ended transition term "comprising," moreover, does not exclude a colorant from existing in the

processing liquid. The first ink was printed on the second ink. See p 13, 1 35-39. The limitations of the

claims, then, are met by the disclosure of the reference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can

normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this

application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311

for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should

be directed to the receptionist whose telephone number is 703-308-2351.

BRUCE H. HESS PRIMARY EXAMINER

Michael E. Grendzynski **Assistant Examiner** February 14, 2003